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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/894,659	06/28/2001	Hiroki Moriyama	14731	6961

7590 02/21/2006

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EXAMINER
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JASTRZAB, KRISANNE MARIE

ART UNIT	PAPER NUMBER
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1744

DATE MAILED: 02/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/894,659

Applicant(s)

MORIYAMA, HIROKI

Examiner

Krisanne Jastrzab

Art Unit

1744

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 25-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Specification*

The incorporation of essential material in the specification by reference to an unpublished U.S. application, foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference, if the material is relied upon to overcome any objection, rejection, or other requirement imposed by the Office. The amendment must be accompanied by a statement executed by the applicant, or a practitioner representing the applicant, stating that the material being inserted is the material previously incorporated by reference and that the amendment contains no new matter. 37 CFR 1.57(f).

Applicant has indicated in the response of 11/15/2004, that the essential material referred to above, is actually present in the original disclosure of the instant application as filed. The Examiner maintains that the specification should then be corrected accordingly to remove the language implying an improper incorporation by reference, for purposes of clarity and completeness. The Examiner would point Applicant to MPEP 608.01 (p) for such authority.

The Examiner would maintain and emphasize that incorporation by reference of a foreign application or patent is not improper if the material being incorporated is **not essential** material, but it is improper for **essential** material. It is not required that Applicant remove the incorporation by reference, just the portion of that reference to **essential** material.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 27 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

This claim is found to be vague and indefinite because "largely deforms" is a relative term and it is unclear as to what would constitute "largely deforms". The functional language is also found to be vague and indefinite leaving the claim unclear as to what structure would actually perform as cited.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 25, 28, 30 and 32-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Hillebrenner et al., U.S. patent No. 5,534,221.

Hillebrenner et al., set forth a container for endoscope sterilization wherein both a tray and lid are provided with an accommodating means for receipt of an endoscope, and with guide means for predetermined placement and protection of the endoscope with means to maintain spatial separation between segments of the endoscope during

treatment while keeping the flexible portion bent. See column 2, lines 40-45 and 55-62, column 3, lines 1-6, and 10-20 and 29-36, and column 6, lines 10-60, column 7, 64-68, and finally column 10, lines 58-68.

Claims 25-32 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Mönch U.S. patent No. 4,730,729.

Mönch teaches a container for sterilization of endoscopes and parts therefor having a vessel having a tray for accommodating an instrument such as an endoscope, with a recessed section to receive the instrument and a lid for cooperatively covering the tray and instrument. Resilient instrument restraint and protection means are provided in both the tray and lid to protect the instrument during sterilization. An outer lid is also provided above the lid that cooperates with the tray. The container has handles thereon and is constructed for high temperature, high pressure sterilization of endoscopes. See Fig. 4-6, 8 and 11. See also column 2, lines 25-50.

With respect to claim 6, see Fig. 4.

Claims 25-34 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Hauze U.S. patent No. 4,798,292.

Hauze teaches a container for sterilization of sensitive medical instruments including a tray having resilient means to receive and protectively support an instrument therein. A lid constructed to cooperate with the resilient means of the tray to protectively support the instrument. A second tray/lid is also taught, which is constructed with recesses spaced to accommodate other small parts of the instrument

to be sterilized. This lid is further covered with the outer lid. See column 4, lines 25-35, column 7, line 18 through column 8, line 20, and Figs. 9 and 10.

Claims 25-27, 30-31 and 33-34 are rejected under 35 U.S.C. 102(a) as being anticipated by JP 2000-060791. See Fig. 1.

### ***Response to Arguments***

Applicant's arguments filed 12/12/2005 have been fully considered but they are not persuasive.

Applicant argues that Hillebrenner fails to teach structure which maintains spatial separation of the parts of the endoscope, however, the Examiner would disagree and point particularly to column 10, lines 58-68 thereof.

Applicant alleges the same of Hauze, however, the Examiner would maintain that Hauze clearly prevents portions of contained instruments from contacting each other.

Applicant finally argues that Mönch fails to contemplate the problems associated with bending of an endoscope, however, the Examiner would note that Mönch is not applied to claims requiring bending of the endoscope.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

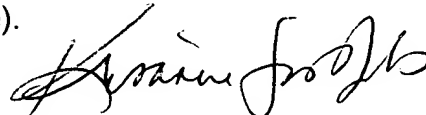
TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krisanne Jastrzab whose telephone number is 571-272-1279. The examiner can normally be reached on Mon.-Wed. 6:30am-4:00pm and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gladys Corcoran can be reached on 571-272-1214. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Krisanne Jastrzab  
Primary Examiner  
Art Unit 1744

February 16, 2006